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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,343	07/26/2004	Hansulrich Reisacher	255666us0pct	6093

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EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,343

Applicant(s)

REISACHER ET AL.

Examiner

Patricia L. Hailey

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicants' remarks and amendments, filed on September 9, 2005, have been carefully considered. No claims have been canceled; new claims 11 and 12 have been added.

Claims 1-12 are now pending in this application.

Support for the amendment to claim 6 can be found in the Specification at page 11, lines 45-46.

Support for new claims 11 and 12 can be found in the Specification at page 11, line 47, at page 12, lines 12 and 13 (for claim 11), and the paragraph bridging pages 10 and 11 (for claim 12).

Withdrawn Rejections

The 112(2)/101 rejection of claim 10 stated in the previous Office Action has been withdrawn in view of Applicants' amendment to this claim.

The 103(a) rejections of claims 1-4 and 7-9 as being unpatentable over Kurtz et al. (U. S. Patent No. 5,082,498) and over Belde et al. (U. S. Patent No. 4,464,203) stated in the previous Office Action have been withdrawn in view of Applicants' persuasive arguments regarding these rejections.

The 103(a) rejections of claims 5 and 6 as being unpatentable over both Kurtz et al. (U. S. Patent No. 5,082,498) and Belde et al. (U. S. Patent No. 4,464,203), each in view of Nyssen (U. S. Patent No. 6,646,023), have both been withdrawn in view of Applicants' persuasive arguments regarding these rejections.

The provisional obviousness-type double patenting rejection of claims 1-10 as being unpatentable over claims 1-8 of copending Application Serial No. 10/501,328 stated in the previous Office Action has been withdrawn in view of Applicants' persuasive arguments regarding this rejection. Although the claims in the copending application are drawn to pigment granules comparable to the instantly claimed invention, the claims in the copending application exclude the presence of an anionic surface-active agent.

New Ground(s) of Rejection

The following New Ground(s) of Rejection are being made in view of the Examiner's reconsideration of the pending claims, in view of the discovery of copending Application Serial No. 10/515,345, and in view of the newly discovered reference to Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. *Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/515,345.*

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to pigment preparations comprising a pigment, at least one anionic surface active agent, and at least one nonionic surface active agent, each of which are comparable to one another.

See, for example, claims 1-5 in the instant application and claim 1 of the '345 application, with respect to the anionic surface active agent. Additionally, the respective sets of claims correspond to one another as follows:

Instant Claims 6-11 correspond to claims 4-20 in the '345 application, and Instant Claim 12 corresponds to claims 2 and 3 in the '345 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. *Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The claims are indefinite because the percentage ranges recited in claim 1 are not commensurate with the claim's requirement that the sum total of the weight percentages are not to exceed 100% by weight (as recited in the last line of claim 1). For example, if component (A) is employed at its maximum percentage of 90%, the percentage ranges of components (B) and (C) do not total 10% or less, based on the recited percentage ranges for these components. Further, it cannot be readily determined if all of these weight percentages are based on the total weight of the pigment preparations, or, for example, if the percentages of components (B) and (C) are based on the total weight of the pigment (i.e., component (A)).

Additionally, claim 9 is indefinite for lacking antecedent basis for the limitation "coatings, paints, inks, or finish systems, where a liquid phase comprises water, organic solvent, or mixtures of water and organic solvent". Claim 8, from which claim 9 depends, does not recite this limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. *Claims 1-5, 7-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266).*

With respect to claims 1-5 and 12:

Gonzalez-Blanco et al. teach pigment preparations comprising at least one pigment, at least one dispersant, and water. See the Abstract of Gonzalez-Blanco et al., as well as col. 1, lines 30-40.

Exemplary pigments, preferably used in an amount of 0.05 to 80% by weight, relative to the pigment preparation, are disclosed at col. 1, line 45 to col. 2, line 46 of Gonzalez-Blanco et al.

Examples of the dispersant include non-ionic and anionic compounds. Exemplary non-ionic compounds include reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols and fatty amines (considered to read upon component (B) in Applicants' claims); exemplary anionic compounds include

alkyl sulfates, ether sulfates, and phosphate esters (considered to read upon component (C) in Applicants' claims, as well as the limitation "ether phosphates"). See col. 2, line 47 to col. 5, line 48 of Gonzalez-Blanco et al.

The dispersant is preferably used in an amount of 0.1 to 200% by weight, relative to the weight of pigments used. See col. 5, lines 49-51 of Gonzalez-Blanco et al.

At col. 6, line 34 to col. 7, line 12, Gonzalez-Blanco et al. disclose the feasibility in employing additional colorants, such as carbon blacks, organic coloring pigments (from the azo, diazo, polyazo, anthraquinone, and thioindigo series), etc., in the aforementioned pigment preparations. These additional colorants can be present in the pigment preparations in amounts ranging from 0 to 80% by weight, relative to the pigment preparation (col. 7, line 66 to col. 8, line 8).

With respect to claims 7-10:

The pigment preparations are prepared for use in printing inks for ink-jet printing by homogenizing the pigment with any optional colorant, at least one portion of the dispersant, and, if desired, with further additives, and optionally subjecting the resultant mixture to dry or wet crushing. See col. 8, lines 26-32 of Gonzalez-Blanco et al.

Alternative methods include introducing and homogenizing the pigment, optional water-soluble colorants, a portion of the dispersant, and water in a stirred vat, dissolver, or similar device, until a homogeneous milled suspension is obtained. See col.

8, lines 57-64 of Gonzalez-Blanco et al., as well as col. 9, lines 5-41, which discusses wet-crushing of the pigment and, if desired, colorants, as well as, in a dilution step, mixing the pigment preparation in water with any remaining amounts of dispersant, and homogenizing the resultant mixture, which is brought to the desired final pigment concentration and color strength of the preparation or printing ink. During this step, it may be desirable to add another portion of dispersant, to avoid reagglomeration of the fine pigment particles in dilution.

In view of these teachings, Gonzalez-Blanco et al. anticipate claims 1-5, 7-10, and 12.

Claim Rejections - 35 USC § 103

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. *Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266) in view of Nyssen (U. S. Patent No. 6,646,023, cited in the previous Office Action).*

Gonzalez-Blanco et al. is relied upon for its teachings as stated in the above 102(b) rejection. Although this reference teaches pigment preparations that read upon claims 1-5, 7-10, and 12, as addressed above, this reference does not explicitly teach the claimed properties of particle size and surface area, as recited in claims 6 and 11.

Nyssen teaches pigment preparations comprising at least one organic or inorganic pigment and at least one compound selected from, inter alia, reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols). See col. 2, lines 41-50 of Nyssen; note that these components are also disclosed in Gonzalez-Blanco et al. as stated above.

The preparations of Nyssen are also disclosed as having a mean particle size of 20 to 2000 μm . See col. 2, lines 53-59 of Nyssen.

At col. 3, lines 1-65, Nyssen discusses exemplary inorganic and organic pigments; note that these pigments are also disclosed in Gonzalez-Blanco et al. at col. 6, line 34 to col. 7, line 12.

Because Nyssen discloses pigment preparations comparable to that of Gonzalez-Blanco et al., said preparations having a particle size comparable to that instantly claimed, one skilled in the art would find reasonable expectation that the pigment preparations of Gonzalez-Blanco et al. would exhibit a particle size within Applicants' claimed range, absent the showing of convincing evidence to the contrary.

With respect to the claimed surface area, one of ordinary skill in the art would also find reasonable expectation that the prior art pigment preparations would also exhibit this property, since the references teach pigment preparations containing the same components as those respectively recited in Applicants' claims, also in percentage amounts reading upon those respectively recited in Applicants' claims. Further, It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Where the claimed and prior art compounds possess a close structural relationship and a specific significant property in common which renders the claimed compounds obvious to one skilled in the art, they are effectively placed in the public domain and unpatentable per se, even though the applicant has discovered that they possess an additional activity. In re Mod, et al. (CCPA 1969) 408 F2d 1055, 161 U. S. P. Q. 281.

Priority

10. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Documents were filed on July 26, 2004.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

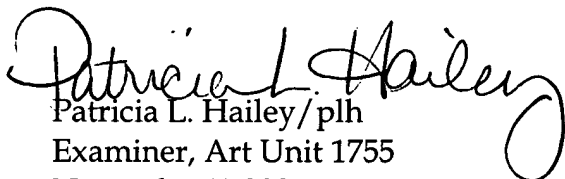
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patricia L. Hailey/plh
Examiner, Art Unit 1755
November 7, 2005


J.A. LORENZO
SUPERVISORY PATENT EXAMINER